

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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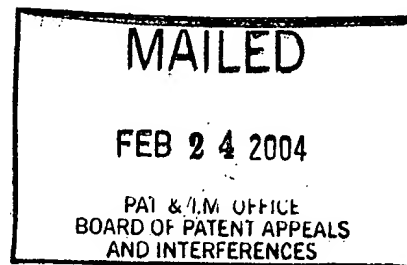
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DIRECTOR OFFICE
TECHNOLOGY CENTER 2000

Ex parte NAOHITO TOMOE

Appeal No. 2002-1129
Application 09/225,245¹

ON BRIEF



Before JERRY SMITH, BARRETT, and BLANKENSHIP, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

Appellant timely filed a request for rehearing (Paper No. 19) (pages referred to as "RR__") on January 26, 2004, requesting reconsideration of our decision (Paper No. 18) (pages referred to as "D__") entered November 25, 2003, in which we

¹ Application for patent filed January 4, 1999, entitled "Device for and Method of Detecting Interference Waves," which claims the foreign filing priority benefit under 35 U.S.C. § 119 of Japanese Applications 10-218350, filed July 31, 1998, and 10-349132, filed December 8, 1998.

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affirmed the rejection of claims 1, 2, 12, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Yoshimi et al. (Yoshimi), U.S. Patent 5,603,093, and the admitted prior art (APA).

We have reconsidered our decision in light of appellant's arguments; however, we are not persuaded of any errors therein. Accordingly, the request for rehearing is DENIED.

OPINION

Appellant argues that our opinion found that the prior art method discussed in the "Background of the Invention" section of Yoshimi is an unpreferred embodiment of Yoshimi, whereas it is actually a discussion of the prior art to Yoshimi (RR1-2).

Our opinion stated that "the prior art method disclosed in the background of Yoshimi is similar to an unpreferred embodiment" (D6). Thus, we clearly identified the background of the invention as a prior art method. The prior art method is similar to a disclosed unpreferred embodiment because it must be evaluated as a teaching of the patent even though it is not the preferred invention. Moreover, even if appellant's reading of our opinion were accurate, appellant has not said how it would be an error affecting the outcome of the decision.

Appellant notes that Yoshimi teaches that the prior art method sometimes leaves a region of an undesired state of reception in the zone and that mobile radio communication service is impaired during the measurement (RR3). It is argued that this

would discourage one of ordinary skill in the art from using the prior art method and, thus, Yoshimi teaches away from using the conventional prior art method (RR3-4).

We stand by the discussion in our opinion (at D5-6) that Yoshimi does not teach away. All of the disclosures in a reference "must be evaluated for what they fairly teach one of ordinary skill in the art." In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Yoshimi's discussion of the prior art is part of the disclosure. The fact that the prior art method may have problems does not constitute a teaching away.

Appellant argues that the invention in claim 12 is neither disclosed nor suggested by Yoshimi (RR4). It is argued that claim 12 is not directed simply to stopping base station transmission while measuring for interference waves in the base station's zone by a dedicated measurement device as discussed by Yoshimi (RR4). It is stated (RR4-5):

In particular, claim 12 requires the step of converting data to be transmitted from a base station into a radio signal of predetermined transmission frequency and transmitting it to a mobile station. Claim 12 also requires receiving a radio signal from said mobile station. Thus, claim 12 necessarily describes a method that must be performed by the base station, since only a base station transmits signals to a mobile station, and receives signals from a mobile station.

It is not known what argument appellant is trying to make. Appellant does not say what is not taught by Yoshimi or why it is not taught unless, by reciting the limitations of claim 12, we

are supposed to draw the conclusion that these limitations are not taught. It is noted that these arguments were not made in the principal brief and are untimely. See Ex parte Hindersinn, 177 USPQ 78, 80 (Bd. App. 1971) (argument advanced in petition for reconsideration not advanced in the brief or the reply brief are not properly before us); cf. Pentax Corp. v. Robison, 135 F.3d 760, 762 (Fed. Cir. 1998) (citing cases supporting the proposition that issues not raised before the court are not addressed on rehearing). Nevertheless, we are not persuaded of any error. The basic functions of a base station in a mobile radio communication systems are to convert data to be transmitted from the base station into a radio signal of predetermined transmission frequency and to transmit it to a mobile station and to receive a radio signal from said mobile station. The base station in Yoshimi performs these functions.

Appellant argues that the final rejection proposes to modify the APA to use the conventional prior art method discussed by Yoshimi and, "[t]hus, the background discussion in Yoshimi does not anticipate claim 12, as the Board's decision appears to insinuate at page 5" (RR5).

It is not stated what the error is that would affect the outcome of our decision. We agree that the final rejection of claims 1, 2, 12, and 13 is based on the combination of Yoshimi and the APA. Since the claims were all rejected under § 103(a)

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and appellant did not separately argue the claims, the Board had the right to select a representative claim for the group. 37 CFR § 1.192(c)(7) (2000). We selected claim 12 because it did not have the structural limitations of claim 1 (although these were not argued in the main brief). We noted that the structure of the APA is not needed for the method of claim 12 (D5, lines 4-6). While it appears that Yoshimi does anticipate the subject matter of method claim 12, and appellant has not explained why it does not, we did not discard the APA. It was simply not necessary to discuss the APA for the limitations contested by appellant in the main brief. However, even if we relied on Yoshimi alone in affirming the rejection, this would not create a new ground of rejection. See In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961) ("the answer specified a rejection on Whitney in view of Harth and if the board found it unnecessary to rely on Harth in sustaining that rejection, as it appears to have done, that does not amount to rejection on a new ground").

We have reconsidered our decision in light of appellant's arguments; however, we are not persuaded of any errors therein. Accordingly, the request for rehearing is DENIED.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Lee E. Barnett

LEE E. BARRETT
Administrative Patent Judge

Howard B. Gordon

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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